

Appl. No. : 09/782,588
Filed : February 12, 2001

REMARKS

Claims 1-4, 6, 7, 10-12, and 18-25 and 27 are presented for examination. Claims 5, 8, 9, and 13-17 and 26 are canceled. Applicants respectfully request entry of Claims 1-4, 10-12, and 18-20 which were previously submitted, but not entered. Support for previously submitted Claim 1 and Claim 18 can be found on page 9, lines 35-38, and page 10, lines 1-24, for example. Accordingly, no new matter has been added. Continued examination of the present case is respectfully requested.

Discussion of Rejection Under 35 U.S.C. § 102

The Examiner has rejected Claims 1-4, 6-7, 9-12, 18-20, and 23-25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,863,722 (Brenner). Applicants respectfully traverse because Brenner does not disclose each and every element of Claims 1-4, 6-7, 9-12, 18-20, and 23-25.

To be anticipatory under 35 U.S.C. § 102, a reference must teach each and every element of the claimed invention. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). "Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. ...There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Claims 1-4, 6-7, and 9-12 are directed to microscope slide compositions that comprise first and second assay locations having discrete sites, wherein the assay locations are separated from each other by a physical border. Similarly, Claims 18-20 and 23-25 relate to methods of making microscope slide compositions comprising first and second assay locations having discrete sites, wherein the assay locations are separated from each other by a physical border.

The claimed microscope slide compositions have first and second assay locations so that a single microscope slide can be used to test several different samples. Practitioners can utilize the multiple assay locations to quickly process and analyze more than one sample

simultaneously. *See* Application, page 1, lines 9-10. As discussed in the specification, physical borders are placed around each assay location so that samples and reagents placed at one assay location do not spill over onto a different assay location. *See* Application, page 10, lines 1-24. Accordingly, Applicants' invention provides an efficient way to quickly analyze a series of desired samples. Specific configurations of microscope slides having multiple assay locations and physical borders are provided in Figures 1A-E.

In the Advisory Action mailed January 5, 2004, the Examiner indicated that the term "physical border" should be construed to encompass a "spacing between assay locations." The Examiner cited page 10, lines 4-6 of the specification for support. Applicants respectfully disagree with this construction of the term "physical border." While both "physical borders" and "spacing" can be used to separate assay locations, they are not inclusive of one another. The specification defines a separable location as "a location on a substrate that is physically separated from other regions on the substrate." *See* Application, page 10, lines 2-3. The separation can be any type of border between assay locations. For example, the separation can be a partition or a spacing between assay locations sufficient at least to distinguish one from the other. Thus it is clear from the specification that "spacing" is a type of separation, as opposed to a type of "border."

In contrast to the pending claims, Brenner fails to teach or suggest microscope slide compositions having physical borders that separate the slide into more than one assay location. The compositions taught by Brenner are designed to perform a single assay, such as sorting and sequencing the polynucleotides of a single mixture. *See* column 2, lines 66 and 67, column 3, line 1. There is no discussion in Brenner of using a microscope slide composition having more than one assay location to analyze multiple biological samples. As Brenner does not teach or suggest each and every element of Claims 1-4, 6, 7, 9-12, 18-20, and 23-25, it could not anticipate these claims. For this reason, Applicants respectfully request the withdrawal of this rejection.

Discussion of Rejection Under 35 U.S.C. § 103

The Examiner rejected Claims 1-4, 6-12, 18-20, 23-25, and 27 under 35 U.S.C. § 103(a) as being unpatentable over WO 98/40726 (Walt) in view of U.S. Patent No. 6,129,896 (Noonan)

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and U.S. Patent No. 6,248,521 (Van Ness). Furthermore, the Examiner rejected Claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Walt, Noonan and Van Ness, and further in view of U.S. Patent No. 6,306,643 (Gentalen).

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Applicants respectfully submit that the cited references fail to teach or suggest all of the elements of the rejected claims. Specifically, Claims 1-4, 6-12, 18-25, and 27 recite microscope slide compositions having first and second assay locations separated from each other by a physical border. In contrast to Applicants' claims, the Examiner has failed to cite any passages in Walt, Noonan, Van Ness or Gentalen that teach multiple assay locations separated by a physical border.

Moreover, a skilled artisan would not be motivated to add physical borders to the teachings of Walt, Noonan, Van Ness or Gentalen. As discussed above, the purpose of the physical borders is to prevent the samples and reagents applied to one assay from mixing with the samples and reagents of another assay location. As the cited art fails to teach or suggest a slide having multiple assay locations, a skilled artisan would not be motivated to add a physical border to separate such assay locations. There would be no reason to keep samples and reagents separate from one another if the composition lacked multiple assay locations.

Thus, for all of the above reasons, Applicants respectfully request withdrawal of the rejections of Claims 1-4, 6-12, 18-20, 23-25, and 27 under 35 U.S.C. § 103, and allowance of the pending application.

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and

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arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Respectfully submitted,

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Dated: 1/29/04

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